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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/064,765 | 04/23/98 | OHNISHI | H 381TO/41092R |

PM82/0509
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EXAMINER

ZANELLI, M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3661

DATE MAILED: 05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/064,765

Applicant(s)

Ohnishi et al

Examiner

Zanelli

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/28/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-7 is/are allowed.
- ☒ Claim(s) 8-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

1. This is responsive to the communication filed 2/28/01. Claims 1-12 are pending.

2. It is noted that a Continuation of this reissue application was filed on 2/4/00.

Applicant is required to make reference to the other application. See MPEP 1451.

3. Claims 8-12 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

A. As per reissue claims 8 and 12, the claims are directed to a system and method for estimating an input torque to be used for controlling an automatic transmission.

Patented claims 1, 2, 4, 5, 6, and 7 are directed to a system and method for controlling selection of a gear position for an automatic transmission. Further, the patented claims include means and steps for estimating output torque whereas the reissue claims do not

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include identical language. Thus, the reissue claims are broader in at least some aspects relative to the patented claims.

B. Since broader aspects have been shown, one looks to see if the broader aspects relate to surrendered subject matter; specifically, prosecution history. The exact language of the patented claims noted in the Reasons for Allowance does not appear anywhere in the reissue claims. The reissue claims attempt to claim the torque estimation system/method separately, as reflected in applicant's remarks filed 6/30/99. The particular situation here corresponds to Example C described in MPEP 1412.02:

"If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists."

"The limitation omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered."

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C. For example, reissue claim 8 at a minimum must include the preamble, output torque estimation means, and wherein clause of patent claim 1 (original application claim 5) because the Reasons for Allowance specifically states:

"Claims 5 ... allowable because the combination of the means/step for estimating the output torque by one of two alternative methods are respectively recited in the claims, depending on whether the ratio between the input and output speeds of the torque converter is greater than a predetermined value, with the other limitations of the respective claims is deemed to have not been taught by the cited prior art".

Since applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue, the omitted limitation(s) is thus established as relating to subject matter previously surrendered.

4. **REMARKS**

A. Applicant's remarks have been duly considered, but are deemed non-persuasive.

B. Applicant argues that claims 8-12 are concerned with "input" torque not "output" torque as set forth in the patented claims. First, the term "input" torque is not explicitly used anywhere in the written description and thus the term itself is open to interpretation. However, one of ordinary skill in the art at the time of invention would have recognized that the terms "input" and "output" are relative in nature. For example, the output torque of the engine could also be referred to as the input torque of the torque convertor. Both the reissue claims and the patent claims (i.e., at least claim

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1) read on Fig. 10. The examiner disagrees that the reissue claims and patent claims are so distinct that the recapture issue is not even raised. To the contrary, claims 8-12 appear to be directed to subject matter included within the scope of the "output torque estimation means". Col. 7, line 13 to col. 8, line 7 describes the manner in which the output torque is estimated whereby the "input" torques now claimed appear to be a subset of or included in the overall structure of the output torque estimation means. Thus, the newly claimed subject matter is broader than the "output torque estimation means" limitation for which the examiner indicated as being the basis for allowing patent claim 1 to issue.

5. Applicant is reminded of the proper procedures for amending claims in a reissue application. See 37 CFR 1.121(b)(2).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Zanelli** whose telephone number is **(703) 305-9756** (M-Th, 6:30-5:00 PM).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1113**.

/mjz
May 7, 2001


MICHAEL J. ZANELLI
PRIMARY EXAMINER